

REMARKS

By this Amendment, Applicants amend claims 1 and 12. Claims 1-13 remain currently pending.

In the Final Office Action, the Examiner allowed claims 6-11 and 13. The Examiner rejected claims 1-5 and 12 under 35 U.S.C. § 112, first paragraph; rejected claims 1, 2, and 12 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,201,968 to Ostroff et al. ("Ostroff") in view of U.S. Patent Application Publication No. 2002/0077103 to Bonta ("Bonta"); rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Bonta and further in view of U.S. Patent No. 5,854,981 to Wallstedt et al. ("Wallstedt"); and rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff¹ in view of Bonta and further in view of U.S. Patent No. 6,112,089 to Satarasinghe ("Satarasinghe").²

Applicants thank the Examiner for allowing claims 6-11 and 13. Applicants respectfully traverse the Examiner's rejections under both § 102 and § 103.

Regarding claim rejection under 35 U.S.C. § 112

Applicants respectfully traverse the Examiner's rejection of claims 1-5 under 35 U.S.C. § 112, first paragraph. The Examiner alleges that "[c]laims 1 and 12 have been amended to include the limitation *wherein the first neighbor list and the second neighbor list are used without determining characteristics of the serving station*. However, . . . , characteristics of the serving base station are determined." (Office Action at 2.)

¹ Applicants note that, in item 6 on page 7 of the Office Action, Examiner listed Ostroff as US 6,188,904, which is different from the previous US 6,201,968 Ostroff reference. For the purpose consistency, Applicants assume that the same reference as the previous Ostroff reference is intended.

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants respectfully disagree with the Examiner's allegation. However, to expedite the prosecution of the present application, Applicants have amended claims 1 and 12 to remove the limitation of "wherein the first neighbor list and the second neighbor list are used without determining characteristics of the serving station." Therefore, the Section 112 rejection of claims 1-5 and 12 is moot.

Regarding claim rejections under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner's rejection of claims 1, 2, and 12 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Bonta, because a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Independent claim 1, as amended,³ recites a combination including, for example, "a setting circuit configured to set priority levels for the peripheral base stations listed in the first and second neighbor lists stored in the memory; [and] a measurement circuit configured to measure, when the mobile communication terminal and the second base station are synchronized with each other, communication quality between the mobile communication terminal and each of the peripheral base stations listed in the first and

³ Support for the amendments may be found at, for example, pages 25-26 of the specification.

second neighbor lists, in a decreasing order of priority level set by the setting circuit.”

Ostroff fails to teach or suggest at least these features of amended claim 1.

Ostroff teaches “[w]hen the subscriber unit (405) obtains a new neighbor cell list (442) from the cell site (428), it determines whether characteristics of the cell site (428) is such that the new neighbor cell list (442) does not adequately reflect available neighboring cell sites. . . . In such cases, the subscriber unit combines entries from its current neighbor cell list (451) with entries from the new neighbor cell list (442) obtained from the cell site to generate a supplemented neighbor cell list (652).” Ostroff, abstract, emphasis added.

Further, Ostroff teaches that “all the entries from the current obtained neighbor cell list are combined with all entries from the downloadable neighbor cell list to form the new list 652. In another embodiment, some or all the entries from the downloaded neighbor cell list are combined with some but not all of the entries from the current neighbor cell list.” Ostroff, column 5, lines 55-60. However, Ostroff fails to teach or suggest at least “a setting circuit configured to set priority levels for the peripheral base stations recited in the first and second neighbor lists stored in the memory,” and “a measurement circuit configured to measure, . . . communication quality between the mobile communication terminal and each of the second plurality of peripheral base stations listed in the first and second neighbor lists, in a decreasing order of priority level set by the setting circuit,” as recited in amended claim 1 (emphasis added).

Bonta fails to cure the deficiencies of Ostroff. Bonta teaches a “method of assigning an optimal system control parameter in a wireless communication system (10).” Bonta, abstract. In Bonta, “based on the location of the mobile 12, cells III and IV

are less than optimal choices as handoff candidates and should not be included in the neighbor list. Therefore, a neighbor list is optimized for grid element 17 to include only neighbors VI and VII rather than being tied to serving cell I. This neighbor list is then provided to the mobile 12 when the GPS assisted location approach locates mobile 12 as being with grid element 17.” Bonta, para. [0025], emphasis added. However, Bonta’s teaching of optimizing the neighbor list by using location information based on grid element does not constitute either “a setting circuit configured to set priority levels for the peripheral base stations listed in the first and second neighbor lists stored in the memory,” or “a measurement circuit configured to measure, . . . communication quality between the mobile communication terminal and each of the peripheral base stations listed in the first and second neighbor lists, in a decreasing order of priority level set by the setting circuit,” as recited in amended claim 1 (emphasis added).

Therefore, neither Ostroff nor Bonta, taken alone or in any reasonable combination, teaches or suggests all elements required by amended claim 1. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of amended claim 1. Because claim 2 depends from claim 1, Applicants also request withdrawal of the Section 103(a) rejection of claim 2 for at least the same reasons as stated above.

Further, amended independent claim 12, while of different scope, includes similar recitations to those of amended claim 1. Amended claim 12 is therefore also allowable for at least the same reasons stated above with respect to amended claim 1. Applicants respectfully request withdrawal of the Section 103(a) rejection of amended claim 12.

Applicants respectfully traverse the Examiner's rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Bonta and further in view of Wallstedt, because a *prima facie* case of obviousness has not been established.

Claim 3 depends from claim 1. As set forth above, Ostroff and Bonta fail to teach or suggest at least “a setting circuit configured to set priority levels for the peripheral base stations listed in the first and second neighbor lists stored in the memory,” and “a measurement circuit configured to measure, . . . communication quality between the mobile communication terminal and each of the peripheral base stations listed in the first and second neighbor lists, in a decreasing order of priority level set by the setting circuit,” as recited in amended claim 1 (emphasis added).

Wallstedt fails to cure the deficiencies of Ostroff and Bonta. The Examiner alleges that “WALLSTEDT discloses wherein a memory stores a neighbor list for a preset time (col. 15, lines 23-col. 16, lines 2; col. 18, lines 8-48; memory updates the neighbor list according to a predetermined time).” (Office Action at 7.) Even assuming the Examiner's allegation is true, which Applicants do not concede, Wallstedt fails to teach or suggest at least the above listed claim elements as recited in amended claim 1 and required by claim 3.

Therefore, none of Ostroff, Bonta, and Wallstedt, taken alone or in any reasonable combination, teaches or suggests all elements required by claim 3. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim 3.

Applicants respectfully traverse the Examiner's rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Bonta and further in

view of Satarasinghe, because a *prima facie* case of obviousness has not been established.

Claims 4 and 5 depend from claim 1. As set forth above, Ostroff and Bonta fail to teach or suggest at least “a setting circuit configured to set priority levels for the peripheral base stations listed in the first and second neighbor lists stored in the memory,” and “a measurement circuit configured to measure, . . . communication quality between the mobile communication terminal and each of the peripheral base stations listed in the first and second neighbor lists, in a decreasing order of priority level set by the setting circuit,” as recited in amended claim 1 (emphasis added).

Satarasinghe fails to cure the deficiencies of Ostroff and Bonta. The Examiner alleges that “SATARASINGHE discloses wherein the pilot signal reception quality is measured (column 2:lines 25-45)” and “SATARASINGHE discloses wherein the neighbor list is obtained by excluding the first peripheral base stations doubly listed as the second peripheral base stations in the second neighbor list (Figures 2 and 3; column 3:lines 16-67).” (Office Action at 7-8.) Even assuming the Examiner’s allegation is true, which Applicants do not concede, Satarasinghe fails to teach or suggest at least the above listed claim elements as recited in amended claim 1 and required by claims 4 and 5.

Therefore, none of Ostroff, Bonta, and Satarasinghe, taken alone or in any reasonable combination, teaches or suggests all elements required by claims 4 and 5. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claims 4 and 5.

Conclusion

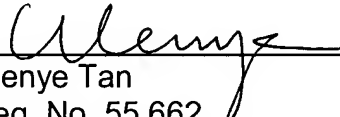
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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